

### REMARKS

This responds to the Office Action mailed on December 17, 2007.

No claims have been amended; claims 1, 4-17, 21, 22, 24, 27-29, 32-35, 37-39, 41-43, 45-57 and 59-65 and 77-79 are canceled herein, claims 2-3, 18-20, 23, 26, 27, 30, 31, 36, 40, 44, 58 and 66-76 were canceled previously, and claims 80-85 have been added. Claims 80-85 are now pending in this application.

Claims 1, 4-17, 21, 22, 24, 27-29, 32-35, 37-39, 41-43, 45-57, 59-65 and 77-79 have been canceled solely to advance the prosecution of the present application, and without prejudice to their further prosecution in an appropriately filed continuing or divisional application.

The new claims have support throughout the specification, including, for example, on pages 1, 9 and 10, and in the previously pending claims. As noted in the specification, oat-based cereal has a tendency to become rancid in a confined space. Traditionally, breathable packages are necessary with oat-based products. However, these packages do not hold a vacuum. (See, for example, pages 1 and 9 of specification). As further stated on page 10 of specification, "It has unexpectedly been found that the combination of the flexible laminated package having an oxygen barrier and a moisture barrier with the expanded oat based cereal made of an oat flour vacuum packaged therein reduced the unexpected result of virtually eliminating rancidity, and nearly doubling the shelf life of the packaged cereal."

No new matter has been added as a result. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

### Rejection of the Claims under Res Judicata

Claims 1, 4-17, 21-22, 24, 27-29, 32-35, 37-39, 41-43, 45-57, 59-65 and 77-79 were rejected on the ground of res judicata since the rejection of each of these claims was affirmed by the Board of Appeals in Appeal No. 2007-2060. Claims 1, 4-17, 21-22, 24, 27-29, 32-35, 37-39, 41-43, 45-57, 59-65 and 77-79 have been canceled, thus rendering this rejection moot.

### §103 Rejection of the Claims

#### 1) The Applicable Law

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Moreover, the Examiner must avoid hindsight. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). That is, the Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to

reconstruct the claimed invention. See *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Furthermore, the Court in *KSR* reaffirmed that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. See also *Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

2) Application of § 103 to rejected claims

Claims 1, 10, 12, 15, 27-29, 41, 42, 59-61, 65, and 77 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beer in view of Thompson et al, Francis, Maglecic et al. McCrosson and Ylvisaker as set forth on pages 4-8 and 17-20 of the Examiner’s Answer dated November 21, 2006. Claims 1, 10, 12, 15, 27-29, 41, 42, 59-61, 65, and 77 have been canceled, thus rendering the rejection moot.

Claims 4 and 48 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker as applied to the claims above, and further in view of Ray as set forth on pages 8-9 of said Examiner’s Answer. Claims 4 and 48 have been canceled, thus rendering the rejection moot.

Claim 49 and 50 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson, Ylvisaker and Ray as applied to claims 4 and 48 above, and further in view of Ours et al. as set forth on pages 9-10 of said Examiner’s Answer. Claims 49 and 50 have been canceled, thus rendering the rejection moot.

Claims 5-8 and 13-14 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker et al. as applied to the claims in paragraph no. 4 above, and further in view of Witkowski as set forth on

pages 10-11 of said Examiner's Answer. Claims 5-8 and 13-14 have been canceled, thus rendering the rejection moot.

Claims 9, 11, 33-35, 37 and 38 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker et al. as applied to the claims in paragraph no. 4 above, and further in view of Galomb as set forth on pages 1-12 of said Examiner's Answer. Claims 9, 11, 33-35, 37 and 38 have been canceled, thus rendering the rejection moot.

Claims 16-17, 21-22, 43, 45-47 and 51-57 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker et al. as applied to the claims in paragraph no. 4 above, and further in view of Thompson et al. (2,478,438) as set forth on pages 12-14 of said Examiner's Answer. Claims 9, 11, 33-35, 37 and 38 have been canceled, thus rendering the rejection moot.

Claim 24 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker et al. as applied to the claims in paragraph no. 4 above, and further in view of Schwab et al. as set forth on page 14 of said Examiner's Answer. Claim 4 has been canceled, thus rendering the rejection moot.

Claim 32 was rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker et al. as applied to the claims in paragraph no. 4 above, and further in view of Kraft Foods Inc. (WO 98/12110) as set forth on pages 14-15 of said Examiner's Answer. Claim 32 has been canceled, thus rendering the rejection moot.

Claims 39, 78, and 79 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker et al. as applied to the claims in paragraph no. 4 above, and further in view of Hellweg et al. as set forth

on pages 15-16 and 20-21 of said Examiner's Answer. Claims 39, 78 and 79 have been canceled, thus rendering the rejection moot.

Claims 62-64 were rejected under 35 USC § 103(a) as being unpatentable over Beer in view of Thompson et al., Francis, Maglecic et al. McCrosson and Ylvisaker et al. s applied to the claims in paragraph no. 4 above, and further in view of Miyake et al. as set forth on pages 16-17 of said Examiner's Answer. Claims 62-64 have been canceled, thus rendering the rejection moot.

Comments on the Opinion of the Board of Patent Appeals and Interferences (September 25, 2007)

In contrast to statements made by the Board in its September 25, 2007 Opinion, Applicant does indeed dispute the Examiner's findings and characterizations of the various references cited throughout prosecution, including in the present Office Action. Applicant traversed rejections and statements made by the Examiner repeatedly throughout prosecution. Therefore, there should be no doubt that Applicant traverses, for example, the characterization that Beer teaches a vacuum sealable bag for packaging food products corresponding to now canceled claims 1 and 77. Applicant notes that Beer further does not teach the vacuum sealed bag recited in claim 80. In contrast to the statement on page 6 of the Opinion, Applicant further disputes the suggestion that a vacuum-sealed opaque oxygen impermeable package, which prevents oxygen and light entry, would necessarily have less than 1 ppm hexanal. Indeed, as the Board notes on page 6 of the Opinion, Beer is silent as to the presence of hexanal.

Remarks re Previously Cited References

Beer does not disclose all the elements of new claim 80. None of the remaining references previously cited teach the elements of claim 80 missing from Beer. Therefore, no combination of any of the previously cited references teaches all elements of claims 80-85. Applicant therefore respectfully requests allowance of claims 80-85.

Reservation of Rights

Applicant reserves the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date March 11, 2008

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11<sup>th</sup> day of March 2008.

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